REMARKS

This application pertains to a novel antistatic pressure-sensitive adhesive tape.

Claims 16-26 are pending, claims 1, 3, 5-13 and 15 being cancelled and replaced by new claims 16-26. The previous claims are being cancelled and replaced by the new claims because it appears that some of the amendments made on April 30, 2008 were not carried forward to subsequent amendments. Further, in view of the present office action it appears that certain amendments would be required, such as the need to amend previous claim 12 (now claim 24) in view of the Examiner's objection to that claim. Therefore, in order to clarify the status of the claims, the previous claims, previous amendments and current amendments are all being presented as new claims 16-26.

The correspondence between the previous claims and the new claims is as follows:

Previous claim number	**New claim number**
1	16
2	Cancelled
3	17
4	Cancelled
5	18
6	19
7	Cancelled

Previous claim number	New claim number
8	20
9	21
10	22
11	23
12	24
13	25
14	Cancelled
15	26

Turning now to the substance of the office action, claim 7 stands objected to for failing to limit the subject matter of the previous claim. The Examiner notes that this claim had previously been cancelled. Claim 7 has now been cancelled and has **not** been replaced by a corresponding new claim, as can be seen from the list above. This objection should now be withdrawn.

Claims 12 and 13 (now claims 24 and 25) stand rejected under 35 U.S.C. 112, first paragraph, because claim 12 recited that the electrically conductive particles could be electrically conductive organic salts. The specification provides support for the previously cancelled electrically conductive ***materials*** to be electrically conductive organic salts, but not for the ***particles*** to be electrically conductive organic salts. In new claims 24 and 25 (previously claims 12 and 13), the electrically conductive organic salts have been deleted, thereby obviating this rejection. The rejection should therefore now be withdrawn.

Claims 6-9 (now claims 19, 20 and 21; claim 7 being cancelled and not replaced) stand rejected under 35 U.S.C. 112, second paragraph, because, with respect to claim 6 (now claim 19) it is unclear to the Examiner what is meant by "shrinkback" and to what degree the PSA exhibits "shrinkback", and with respect to claims 7-9 (now 20 & 21, claim 7 being cancelled and not replaced) the Examiner finds it unclear as to what the symbol "/" means with respect to whether the layers separated by "/" exclude any intervening layers between them. The symbol "/" is conventional in this art, and clearly relates to the sequence of layers. More specifically, the sequence A/B/C/D means that e.g. layer B follows layer A, and there are no layers between them.

More important, however, is the fact that Applicants' amendment of April 30, 2008 cancelled claim 7 and amended claims 8 and 9 to eliminate use of the symbol "/", and the amendments made then are incorporated into the present set of claims, specifically claims 20 and 21 (corresponding to previous claims 8 and 9).

With regard to "shrinkback", Applicants have already explained to the Examiner that this term is well understood in this art, and, as used herein, refers to the tendency of an oriented PSA to contract. The term will clearly be understood by anyone who reads the test by which shrinkback is determined in the present application. See the test for measurement of shrinkback explained beginning at page 18, line 33 of the specification.

In response, the Examiner argues that the claims do not define what is meant by shrinkback and that although shrinkback is defined within the specification, limitations from the specification are not read into the claims.

Once again, Applicants emphasize that "shrinkback" is very well known to those skilled in the art, and such persons would not have to resort to Applicants' specification to understand the meaning of that term, and certainly would not have to read Applicants' specification into the claim. As an example, the Examiner's attention is respectfully drawn to U.S. Patent 7,022,408, specifically, Col. 6, line 65 - Col. 7, line 16; and Col 12, line 52 - Col. 13, line 24. From this, the Examiner will see that the meaning of "shrinkback" is published and is well-established in this art.

In view of the foregoing, the rejection of claims 6-9 (now claims 19, 20 and 21) under 35 U.S.C. 112, second paragraph, should now be withdrawn.

Claim 1 (now claim 16) stands rejected under 35 U.S.C. 102(b) as anticipated by DE 196 12 367, relying on an English translation provided by the Examiner. The Examiner finds that the hardenable silicone resin having conductive particles disclosed by the reference is equated to read on Applicants' primer layer.

The silicone resin coating of the '367 reference is a release layer, however. A release layer is the technical opposite, i.e., the antitheses, of a "primer layer". A primer layer is an adhesion promoter, whereas a release layer, such as the silicone layer of the '367 reference, is an antiadhesive.

Accordingly, the silicone layer of the '367 reference cannot be equated to Applicants' primer layer.

Moreover, Applicants' claims pertain to an adhesive tape, having a carrier layer, a primer layer and an adhesive. The '367 reference is concerned with applying an adhesive tape to a substrate coated with the silicone layer. The adhesive tape of the '367 reference does not have a primer layer, and certainly the release layer that it is applied to in order to test "separation value" is not a primer. The separation value test disclosed on pages 12 and 13 of the reference, mentioned by the Examiner, is a test of the anti-adhesive property of the antiadhesive films.

The adhesive tapes themselves do not have a primer, and certainly nothing that functions as a primer layer.

The '367 reference does not teach or suggest a primer, and certainly does not teach or suggest anything about the inclusion of electrically conductive particles in a primer layer.

The rejection of claim 1 (now claim 16) under 35 U.S.C. 102(b) as anticipated by DE 196 12 367, relying on an English translation provided by the Examiner, should now be withdrawn.

Claims 1, 3, 5 - 7 and 11-13 (now claims 16, 17, 18-19 and 23-25) stand rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371).

The Examiner contends that it would be obvious to use the electrically conductive particles of Akhter in the primer layer of Wallner.

However, as previously pointed out, Wallner's antistatic polymer is a hydrophilic film-forming ionogenic polymer which provides ionic conductivity in the presence of moisture (col. 2, lines 28-30). Wallner does not teach or suggest anything about a primer layer that contains conductive particles.

The Akhter reference, on the other hand relies on conductive particles within both the primer layer and in the PSA layer as well, which particles extend from a first surface of the PSA layer to a second surface of the PSA layer; the first surface of the PSA layer being in intimate and binding contact with the second surface of the primer layer.

In the face of this explanation by Applicants, the Examiner argues that Wallner makes it clear that the incorporation of an antistatic agent in the adhesive will result in inferior adhesive.

However, Wallner completely avoids the use of ***any*** particles, by using an ionogenic polymer in his primer layer instead. Those skilled in the art would understand that the electrical conductivity of the ionogenic polymer of the Wallner reference

operates by a completely different principle than that of Akhter's particles. In fact, Wallner clearly states that he does not understand why his ionogenic polymer-loaded primer works to dissipate the electrical charge (col. 1, lines 62-68).

Akhter, on the other hand, teaches that the electrically conductive particles must be used in sufficient amounts such that particle-to-particle contact is made essentially throughout the binder resin (col. 3, lines 39-41).

Clearly, Akhter dissipates the electrical charge through electrical conduits formed by particle-to-particle contact through the primer to and through the adhesive.

Those skilled in the art would understand that this particle-to-particle contact is necessary to conduct the electrical charge through the adhesive and the primer.

No person skilled in the art reading Akhter and Wallner would replace the ionogenic polymer in Wallner's primer with electrically conductive particles without also loading the adhesive with electrically conductive particles, as there is no evidence or suggestion that such a primer alone would accomplish anything. Those skilled in the art would understand that particle-to-particle contact through both the primer and adhesive would be needed. Especially in view of Wallner's statement that he does not understand why the ionogenic polymer loaded primer is successful (col. 1, lines 62-68)! No person skilled in the art would have any reasonable expectation of success in loading a primer with electrically conductive particles without also loading the adhesive with conductive particles, both in sufficient amounts to form particle-to-particle contact

through the primer, to the adhesive, and then through the adhesive.

If electrically conductive particles were to be avoided, then one would use Wallner's ionogenic polymer instead.

Those skilled in the art would read Akhter as requiring conductive particles in both the adhesive layer and the primer layer, and would not be led to add conductive particles to the primer layer alone without also adding them to the PSA layer. Note that Applicants' main claim excludes electrically conductive particles from the PSA layer!

The Examiner relies on the Roeder reference to show that polyacrylates are elastomers, and would necessarily, in the Examiner's opinion, exhibit shrinkback. The Examiner, however, has derived his own definition of shrinkback, and the meaning he assigns to that term is different than that understood by those skilled in the art, as explained above.

Further, nothing about the presence or absence of shrinkback would overcome the fact that no combination of Wallner and Akhter could ever lead those skilled in the art to an adhesive tape having a primer layer, which primer layer contains electrically conductive particles, without requiring electrically conductive particles in the adhesive as well.

Accordingly, no combination of Wallner and Akhter, with or without Roeder could ever lead to Applicants' novel antistatic pressure sensitive adhesive tape, and the

rejection of claims 1, 3, 5-7 and 11-13 (now claims 16, 17, 18-19 and 23-25) under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371), should now be withdrawn.

Claims 8 and 9 (now claims 20 and 21) stand rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371), as applied to claim 1 above, and further in view of Kitamura et al (US 5,759,679).

The differences between Applicants' antistatic pressure sensitive adhesive tape and anything that can be learned from the Wallner/Akhter/Roeder combination of references are discussed above. The Examiner relies on Kitamura for a teaching of a particular structure of a PSA tape.

However, no particular structure, i.e., sequence of layers, can compensate for the failure of the Wallner/Akhter/Roeder combination of references to teach or suggest anything at all about a pressure sensitive adhesive having a primer between the backing and the adhesive, where the primer, but not the adhesive, comprises electrically conductive particles.

The rejection of claims 8 and 9 (now claims 20 and 21) under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371), as applied to claim 1 above, and further in view of Kitamura et al (US 5,759,679) should therefore now be withdrawn.

Claim 10 (now claim 22) stands rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371), as applied to claim 1 above, and further in view of Lühmann et al. (US 6,395,389).

The differences between Applicants' antistatic pressure sensitive adhesive tape and anything that can be learned from the Wallner/Akhter/Roeder combination of references are discussed above. The Examiner relies on Lühmann for a teaching of a punched adhesive tape strip.

A punched tape strip cannot in any way overcome the failure of the Wallner/Akhter/Roeder combination of references to teach or suggest anything at all about a pressure sensitive adhesive having a primer between the backing and the adhesive, where the primer, but not the backing or adhesive, comprises electrically conductive particles.

Accordingly, the rejection of claim 10 (now claim 22) under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371), as applied to claim 1 above, and further in view of Lühmann et al. (US 6,395,389) should now be withdrawn.

Claims 12 and 13 (now claims 24 and 25) stand rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as

evidenced by Roeder (US 3,672,371), as applied to claim 1 above, and further in view of Craig et al. (US 6,299,799).

The differences between Applicants' antistatic pressure sensitive adhesive tape and anything that can be learned from the Wallner/Akhter/Roeder combination of references are discussed above. The Examiner relies on Craig for a ceramer composition comprising an electrically conductive polymer.

The Examiner contends that it would be obvious to use the electrically conductive particles including electrically conductive polymers of Akhter in the amount taught by Craig.

However, there is nothing in Craig that would teach or suggest anything that would overcome the teaching of Akhter which requires conductive particles in both the adhesive layer and the primer layer, and nothing in Craig would lead those skilled in the art to add conductive particles to the primer layer without also adding them to the PSA layer.

Accordingly, no combination of Wallner, Akhter, Roeder, and Craig could ever lead to Applicants' novel antistatic pressure-sensitive adhesive tape, and the rejection of claims 12 and 13 (now claims 24 and 25) under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371), as applied to claim 1 above, and further in view of Craig et al. (US 6,299,799) should now be withdrawn.

In view of the present amendments and remarks it is believed that claims 16 - 26 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account No. 14-1263.

Respectfully submitted,
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